

Appl. No. 10/071,968  
Amdt dated October 20, 2003

### REMARKS/ARGUMENTS

In the above-identified Office Action, the Examiner indicated that Claims 31-46 and 49-52 are allowed. For this reason these claims are not discussed below.

In the above-identified Office Action, the Examiner indicated on page 2 in paragraph 1 that Claim 49 is to be amended to depend from Claim 31, and this has been done as shown above. Accordingly, Claim 49 is not discussed any further.

At paragraph 3 on page 2 of the above-identified Office Action, the Examiner rejected Claims 14 and 16 as being anticipated by Moore. These two claims are now canceled without prejudice, and Applicant reserves the right to prosecute these claims in a future continuation application.

At paragraph 4, on page 2 of this Office Action, the Examiner objected to Claims 17-29, 47 and 48 as being dependent upon a rejected base claim. Claims 17 and 18 have been amended to recite all limitations of Claim 14, and therefore both these claims are now in form for allowance. The remaining Claims 19-29, 47 and 48 depend either directly or indirectly from Claim 18, and therefore these claims are also in form for allowance.

Finally, in paragraph 5 on page 2 of the Office Action, the Examiner indicated that references BB and CC on the previously-submitted Information Disclosure Statement (IDS) "are not cited since such are not proper references." Applicant respectfully requests the Examiner to re-consider this decision, in view of a recent case by the Court of Appeals for the Federal Circuit (CAFC), namely DAYCO PRODUCTS, INC. v. TOTAL CONTAINMENT, INC., 02-1497 decided May 23, 2003, wherein the court stated as follows (emphasis added):

This court has never addressed whether the prior rejection of a substantially similar claim in a copending United States application is material under the reasonable examiner standard. The District Court for the Northern District of Indiana addressed this issue, "find[ing] that it was important for [an examiner] to know that another knowledgeable Patent Examiner had carefully examined and rejected all claims of [another] application, including claims that were directly related to claims in the [present] application, on the grounds that the claims were obvious in light of prior art patents." Golden Valley Microwave Foods, Inc. v. Weaver Popcorn Co., 837 F. Supp. 1444, 1474 (N.D.

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Ind. 1992). Without such a disclosure requirement "applicants [may] surreptitiously file repeated or multiple applications in an attempt to find a 'friendly' Examiner." ABA Section of Intellectual Property Law, Annual Report 1993-1994 (1994).

We hold that a contrary decision of another examiner reviewing a substantially similar claim meets the Akron Polymer "reasonable examiner" threshold materiality test of "any information that a reasonable examiner would substantially likely consider important in deciding whether to allow an application to issue as a patent." 148 F.3d at 1382, 47 USPQ2d at 1534 (emphasis in original). Patent disclosures are often very complicated, and different examiners with different technical backgrounds and levels of understanding may often differ when interpreting such documents. Although examiners are not bound to follow other examiners' interpretations, knowledge of a potentially different interpretation is clearly information that an examiner could consider important when examining an application.

We also hold that the information meets the threshold level of materiality under new Rule 56, in that "[i]t refutes, or is inconsistent with, a position the applicant takes in . . . [a]sserting an argument of patentability." 37 C.F.R. § 1.56(b)(2) (2002). When prosecuting claims before the Patent Office, a patent applicant is, at least implicitly, asserting that those claims are patentable. A prior rejection of a substantially similar claim refutes, or is inconsistent with the position that those claims are patentable. An adverse decision by another examiner, therefore, meets the materiality standard under the amended Rule 56.

Applicant cited the Examiner's Office Action in the related case 10/072,598 as item "BB" in the IDS because this document is an Office Action which contains "a prior rejection". Therefore, document "BB" of the IDS should be considered a "proper reference" in view of the above remarks by the Court of Appeals for the Federal Circuit. For this reason, the Examiner is respectfully requested to review this document "BB" and state on the record that the claims in the current patent application are patentable over information in document "BB."

SILICON VALLEY  
PATENT GROUP LLP  
2350 BLOSSOM CORPDR TOWER  
SUITE 360  
SANTA CLARA, CA 95054  
(408) 982-8200  
FAX (408) 982-8210

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In addition, Applicant submits that document "CC" of the IDS should be considered a "proper reference" for reasons similar to those discussed above. In fact, Applicant would like the Examiner to carefully consider the entire file history of the related case 10/072,598 and approve the claims in the current patent application after such consideration.

Applicant also submits that the Examiner should NOT be concerned that the patent office procedure does not permit items "BB" and "CC" to be cited simply because they pertain to an application that is currently still pending. There is support in the MPEP for the Examiner to review pending applications (that are not yet issued). See, for example, MPEP § 609, subsection III.(D) which is reproduced below in pertinent part (emphasis added):

If a U.S. patent application number is listed on a PTO-1449 or PTO/SB/08A and 08B form or its equivalent and the examiner considers the information and initials the form, the application number will be printed on the patent.

Applicants may wish to list U.S. patent application numbers on other than a form PTO-1449 or PTO/SB/08A and 08B format to avoid the application numbers of pending applications being published on the patent. If a citation is not printed on the patent but has been considered by the examiner in accordance with this section, the patented file will reflect that fact as noted in C(2) above.

Applicant does NOT wish to "avoid the application numbers of pending applications being published on the patent". Therefore, Applicant respectfully requests that the entire file history of the copending application 10/072,598 be stated on the record as being considered by the Examiner as to its relevance to the patentability of the claims in the current application. This is required by the above-cited Dayco case wherein the CAFC stated

The Manual of Patent Examiner Procedure ("M.P.E.P.") makes clear that "if an inventor has different applications pending in which similar subject matter but patentably indistinct claims are present that fact must be disclosed to the examiner of each of the involved applications." M.P.E.P. § 2001.06(b) (court's emphasis).

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Applicant assumes the Examiner is being kept informed by the USPTO about the current case law, including the various implications of the Dayco case which was only recently decided, in May of this year. If the Examiner needs a copy of the Dayco case, he is respectfully requested to call the undersigned.

In view of Dayco case, Applicant submits that Applicant has fulfilled his duty to inform the Examiner of the related case 10/072,598 and all documents present in its file history. It is now the Examiner duty to make a statement on the record indicating consideration of the file history of the related case. The Examiner's statement can be in the form of any written document that can be signed by the Examiner (in accordance with the patent office rules). The Examiner's statement should explicitly indicate each document that has been reviewed. In this context, Applicant brings to the Examiner's attention the following statement in the originally-filed IDS (see page 2 in the middle of the page, in the IDS dated July 7):

Applicant assumes that the Examiner will monitor the related application 10/072,598 for any future Office Actions and Amendments and any new References being cited therein and take them into account in determining patentability of claims in the above-identified patent application. If this assumption is incorrect, Applicant respectfully requests the Examiner to so state on the record, in the next Office Action.

No additional fees are believed to be due for consideration of these items because the IDS was previously filed. However, if any fee should be required, please charge the Deposit Account 50-2263 while referencing the Docket No. CLX018 US.

Should the Examiner have any questions concerning this paper, the Examiner is invited to call the undersigned at (408) 982-8200, ext. 3.

CERTIFICATE OF FACSIMILE TRANSMISSION  
I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office to the fax number 703-872-9319 on October 20, 2003

*S. Omkar*  
Attorney for Applicant(s)

*Oct 20, 2003*  
Date of Signature

Respectfully submitted,  
Omkar K. Suryadevara

*S. Omkar*

Attorney for Applicant  
Reg. No. 36,320

SILICON VALLEY  
PATENT GROUP LLP  
2350 Mission College Blvd  
Suite 960  
Santa Clara, CA 95054  
(408) 982-8200  
FAX (408) 982-8210